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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,904	09/05/2003	James D. Parsons	378-21-034	7685
23935	7590	05/03/2005		
KOPPEL, JACOBS, PATRICK & HEYBL 555 ST. CHARLES DRIVE SUITE 107 THOUSAND OAKS, CA 91360			EXAMINER GABOR, OTILIA	
			ART UNIT 2878	PAPER NUMBER

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,904

Applicant(s)

PARSONS, JAMES D. GM

Examiner

Otilia Gabor

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2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09/05/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6, 7, 8, 18, 19-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The term "low enough" in claim 6 is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Neither the specification nor the claim defines how low or how high the non-dopant impurity can be in order to not interfere with the structure.

4. The term "approximately uniform" in claim 7 is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Neither the specification nor claim defines what this term means (no quantifiers present to allow one to determine how much uniformity is actually claimed).

5. The term "approximately flat" in claim 8 is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would

not be reasonably apprised of the scope of the invention. Neither the specification nor the claim defines what "approximately flat" means (no quantifiers present to allow one to determine how flat the surface needs to be).

6. The term "approximately uniform" in claim 18 is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Neither the specification nor claim defines what this term means (no quantifiers present to allow one to determine how much uniformity is actually claimed).

7. The term "substantially uniform" in claim 19 is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Neither the specification nor claim defines what this term means (no quantifiers present to allow one to determine how much uniformity is actually claimed).

8. The term "low enough" in claim 22 is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Neither the specification nor the claim defines how low or how high the non-dopant impurity can be in order to not interfere with the structure.

9. The rest of the claims are rejected as being dependent from a rejected claim.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No.

6,713,762. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the parent and the present claims is that the parent claims a SiC thickness of at least 200 micrometers and the present thickness is at least about 400 micrometers. However, since the parent patent claim a thickness that is greater than 200 micrometers it does encompass the presently claimed 400 micrometer thickness as well. Alternately, claiming a specific thickness value from a contemplated thickness range is an obvious feature, since it has been held that discovering an optimum value of an effective variable involves only routine skill in the art (*In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-5, 7-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichikawa (U. S. Patent 5,025,243).

Ichikawa discloses an electromagnetic radiation detection system and method (Fig.1A) comprising a body F of SiC (see Col.1, lines 49-50) at least 200 micrometer thick (see Col.1, line 64) and a detector (including electrodes A) arranged to detect infrared radiation absorption by the SiC body F (see Col.3, lines 43-64) and to detect changes in the resistance of the SiC body F in response to the body receiving radiation having a wavelength less than about 10 micrometers (see Col.3, lines 48-49). Ichikawa fails to specifically disclose that the radiation has a wavelength of less than 10 micrometers, however it would have been obvious to one having ordinary skill in the art at the time the invention was made to recognize that infrared radiation of the type irradiated to the body F in the system of Ichikawa is fairly described as radiation having a wavelength less than about 10 micrometers since the range covers the wavelength ranges described as "near" and "intermediate" infrared. Also, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the detector in the system disclosed by Ichikawa was arranged to detect physico-chemical processes inside the body F which serve to explain the response of the body F to

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radiation. Ichikawa fails to specifically disclose that the thickness of the SiC body is at least 400 micrometers, however using a thicker body would have been obvious to one having ordinary skill in the art since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art (*In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)), and discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955)) especially given that a higher thickness for the SiC body does not improve the absorption but merely changes its size. Additionally, since Ichikawa does not disclose that the thickness of the body F changes throughout or that its surface roughness changes, it is assumed that the body F has uniform thickness and a flat surface.

Regarding claims 2, 10, 15, 20 Ichikawa discloses that the detector system detects infrared radiation absorption by the SiC body F (see Col.1, lines 54-58).

Regarding claims 4, 12, 17, 21 Ichikawa discloses that the detector system detects increases in the resistance of the SiC body F in response to the radiation because increases are a part of the changes described in Col.1, lines 54-58.

Regarding claims 5, 13 Ichikawa places no limitation on the infrared radiation which irradiates the SiC body F and therefore it would have been obvious to one having ordinary skill in the art to retain the features described at Col.1, lines 14-18 and implement the system for a broad band of wavelengths or a narrow band of wavelengths creating the arrangement of a filter. A filter to limit reception of specific radiation is a routine approach in this field.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Otilia Gabor whose telephone number is 571-272-2435. The examiner can normally be reached on Monday, Thursday-Friday between 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on 571-272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Otilia Gabor
Examiner
Art Unit 2878

